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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,826	09/24/2003	Jim B. Surjaatmadja	HES 2002-IP-007850U1	6993
29920	7590	11/01/2005	EXAMINER	
JOHN W. WUSTENBERG			SMITH, MATTHEW J	
P.O. BOX 1431			ART UNIT	
DUNCAN, OK 73536			PAPER NUMBER	

3672

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/669,826	SURJAATMADJA ET AL.	
	Examiner	Art Unit	
	Matthew J. Smith	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-53 is/are allowed.
- 6) ☒ Claim(s) 1-3, 16-19, 33, 36-38 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 4-15, 20-32, 34, 35, and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>18Feb05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 16, 18, 19, 33, 36-38, and 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Malone (4349204).

Malone discloses a fluid inflatable packer comprising an inflatable element 21 exposed to the packer interior, the inflatable element inflates and deflates with process fluid pressure in the interior of the fluid inflatable packer; a mandrel 40 having a plurality of openings 42 along its length; the inflatable element disposed about the mandrel; the packer interior being the mandrel interior; the inflatable element exposed to the interior of the mandrel through the openings; an inflation chamber (next to openings 42) formed between the inflatable element and the mandrel; the inflatable element inflated by fluid provided through the openings to the inflation chamber; at least half of the inflatable element is exposed directly to the interior of the fluid inflatable packer; an open mandrel 40 having a longitudinal passageway; the open mandrel directly exposes the inflatable element to process fluid and process fluid pressure in the longitudinal passageway; at least one tensioning collar 31 maintaining the inflatable element in tension about the open mandrel when the fluid inflatable packer is in a deflated state and when the fluid inflatable packer is in an inflated state; and the inflatable element inflates and deflates with process fluid pressure in the longitudinal passageway.

This reference also discloses a method of treating a subterranean formation, comprising the steps of: pumping a process fluid to a fluid inflatable packer 10; passing the process fluid through the inside of the packer to an inflatable element; inflating the inflatable element with the process fluid; passing the process fluid through an open mandrel of the packer to the inflatable element; inflating the inflatable element with process fluid pressure in the open mandrel; deflating the inflatable element with process fluid pressure in the open mandrel; inflating a fluid inflatable packer with process fluid pumped down a tubing string (col. 2, line 48) to a process tool 40 coupled to the fluid inflatable packer; deflating the fluid inflatable packer by dropping process fluid pressure in the tubing string; positioning a downhole tool assembly having a packer 10 and a process tool 40; pumping a process fluid to the packer and the process tool; inflating the packer by passing the process fluid into an inflation chamber of the packer; performing the treatment (testing, col. 2, line 48) using the process fluid; terminating pumping of the process fluid; and deflating the packer by passing the process fluid out of the inflation chamber as a result of a drop in process fluid pressure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malone in view of Watson et al. (6575251).

Malone discloses a fluid inflatable packer comprising an inflatable element 21 exposed to an interior of the fluid inflatable packer, wherein the inflatable element inflates and deflates with process fluid pressure in the interior of the fluid inflatable packer but not a screen or sand in the fluid.

Watson et al. show a screen 54 in a fluid inflatable packer 56 to restrict the flow of gravel (col. 9, line 41) but not sand (col. 7, lines 13-21).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to include a screen with a packer, as shown by Watson et al., in order to filter the fluid and allow sand in the fluid.

Allowable Subject Matter

Claims 43-53 are allowed.

Claims 4-15, 20-32, 34, 35, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments, see page 12, filed 21 September 2005, with respect to claims 13-15 and 28-30 have been fully considered and are persuasive. The 35 U.S.C. 102 and 103 rejections of claims 13-15 and 28-30 have been withdrawn.

The argument with respect to Malone, on pages 12-15, is not convincing. The absence of a discussion of filtering or not filtering the inflating fluid does not permit applicants to decide filtering is disclosed. The examiner contends without specific structure to filter the inflating fluid, Malone's fluid can be considered unfiltered. Along this line of reasoning, applicants do not recite any structural feature in claims 1, 19, 33, 37, 41, or 42 to facilitate unfiltered fluid. The examiner notes Malone could make the ports bigger to handle unfiltered fluid containing, say, gravel to pass through without a change in function.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3672

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS *MJS*
21 October 2005